REMARKS

Upon entry of the foregoing amendment, Claims 1-11 and 13-20 will remain pending in the application. Claims 1 and 11 have been amended. The amendments are supported by the specification at least in paragraphs [0070]-[0074] and Figure 5. These amendments do not introduce new matter, and their entry is respectfully requested.

In the Office Action of December 24, 2008, the Examiner sets forth a number of grounds for rejections. These grounds are addressed individually and in detail below.

Claim Rejections Under 35 U.S.C. § 103 (a)

Claims 1-11 and 13-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable by U.S. Patent Application Publication No. 2005/0083741 A to Chang (hereinafter "Chang") in view of U.S. Patent Application Publication No. 2006/0279642 A1 to Yoneda (hereinafter "Yoneda") for the reasons set forth on pages 3-16 of the Office Action. Applicants respectfully traverse the rejection. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In this case, independent Claim 1, as amended, is directed to a method of AutoRun using a semiconductor storage device, the semiconductor storage device being coupled to a host computer having an operation system with an AutoRun mechanism, comprising: 1) the operation system of the host computer sending out an inquiry command to the semiconductor storage

device for detecting a type of the device; 2) the semiconductor storage device replying to the inquiry command from the operation system based on one or more predetermined device types; 3) the operation system of the host computer deeming the semiconductor storage device as one type of the predetermined device types according to the reply from the semiconductor storage device, and performing an operation accordingly; and 4) the AutoRun mechanism of the operation system searching for an AutoRun configuration file stored in the semiconductor storage device which simulates said deemed device type so that a specific file directed by the searched AutoRun configuration file can be executed by the operation system, wherein an AutoRun program is preset in the semiconductor storage device coupled to the host computer and capable of directing the specific file; and the AutoRun program is directed by the AutoRun configuration file, wherein the searching step comprises: the operation system accessing the AutoRun configuration file stored in the semiconductor storage device to search for the AutoRun program, and starting a timing program with a predetermined timing value; executing the AutoRun program to search for the specific file, copying the AutoRun program and the specific file to be executed to a host disk of the host computer; the AutoRun program in the semiconductor storage device calling the copy of the AutoRun program in the host disk of the host computer to execute the copy of the specific file in the host disk of the host computer; and the timing program sending out a reset command to the semiconductor storage device when time arrives at the predetermined timing value.

Independent Claim 11, as amended, is directed to a method of AutoRun using a semiconductor storage device, the semiconductor storage device being coupled with a host computer having an operation system with an AutoRun mechanism, comprising: 1) the operation system of the host computer sending out a first inquiry command to the semiconductor

storage device for detecting the type of the device; 2) the semiconductor storage device replying to the first inquiry command from the operation system that the device is an optical disk drive; 3) the operation system of the host computer deeming the semiconductor storage device as an optical disk based on the reply from the semiconductor storage device, and performing an operation accordingly; and 4) the AutoRun mechanism of the operation system searching for an AutoRun configuration file stored in the semiconductor storage device which simulates an optical disk drive so that a specific file directed by the AutoRun configuration file can be executed, the searching step comprising: (4-1) the operation system sending out a second inquiry command to detect whether an optical disk is inserted into the optical disk drive when the semiconductor storage device is deemed to be an optical disk drive; (4-2) in response to the second inquiry command, the semiconductor storage device, which simulates an optical disk drive, replying to the operation system after a predetermined delay, that an optical disk is already inserted into the optical disk drive so that the operation system can deem the semiconductor storage device as an optical disk with an optical disk; and (4-3) the AutoRun mechanism of the operation system searching for the AutoRun configuration file stored in the semiconductor storage device which simulates the optical disk drive with an optical disk so that the operation system can execute the specific file directed by the AutoRun configuration file, wherein an AutoRun program is preset in the semiconductor storage device coupled to the host computer and capable of directing a specific file; and the AutoRun program is directed by the AutoRun configuration file, wherein the step (4-3) comprises: the operation system accessing the AutoRun configuration file stored in the semiconductor storage device to search for the AutoRun program, and starting a timing program with a predetermined timing value; and executing the AutoRun program in the semiconductor storage device to search for the specific file, copying the AutoRun

program in the semiconductor storage device and the specific file to be executed to a host disk of the host computer; the AutoRun program in the semiconductor storage device calling the copy thereof in the host disk of the host computer to execute the copy of the specific file in the semiconductor storage device.

In contrast, Chang generally describes an integrated circuit memory device with incorporated AutoRun functionality. Chang fails to teach or suggest "the AutoRun program in the semiconductor storage device calling the copy thereof in the host disk of the host computer to execute the copy of the specific file in the semiconductor storage device," as recited in claims 1 and 11 of the instant application.

Specifically, Chang does not teach or suggest the AutoRun program in the semiconductor storage device calling the copy of the AutoRun program in the host disk. Chang also fails to teach or suggest that the specific file to be executed by the copy of AutoRun program in the host disk is copied to the host. The Examiner alleges that "Chang discloses, on page 2, paragraph 0029, that the auto run firmware informs the host of the presence of an auto run executable file and those files are then provided to the host computer." The Examiner interprets this as the executable files are transferred to the host computer. Applicant respectfully disagrees.

Chang only provides an autorun executable file (e.g., a file named "Autorun.inf") to the host. The host runs the autorun executable file (i.e., "Autorun.inf") to provide the autorun functionality. Chang, however, does not teach or suggest copying the AutoRun program and the specific file to be executed by the AutoRun program to the host computer, as recited in Claims 1 and 11.

Yoneda does not cure the deficiency of Chang. Yoneda generally describes an electronic still camera for converting captured optical images into electric image signals and is cited for its teachings on timing means. Yoneda fails to teach or suggest that the AutoRun program in the semiconductor storage device calls the copy of the AutoRun program in the host computer to execute the copy of the specific file in the host computer, as recited in Claims 1 and 11 of the presnt application. For this reason alone, the present Claims 1 and 11 are patentable over Chang and Yoneda., because the cited references, individually or in combination, fail to teach or suggest all the claimed limitations.

In addition, Chang teaches switching from the autorun functionality to a common storage by a re-enumeration process. Chang does not need the timing mechanism described in Yoneda and therefore, there is no reason to motivate a person of ordinary skill in the art to introduce the timing mechanism of Yoneda into Chang's system.

Accordingly, Applicants respectfully submit that Claims 1 and 11 are patentable over Chang and Yoneda. Further, Claims 2-10 and 13-20 are patentable over Chang in view of Yoneda because they depend from one of Claims 1 and 11 and recite additional patentable subject matter.

In view of the foregoing, Applicants respectfully submit that the grounds for this rejection have been obviated and that withdrawal of the rejections 35 U.S.C. § 103 (a) is respectfully requested.

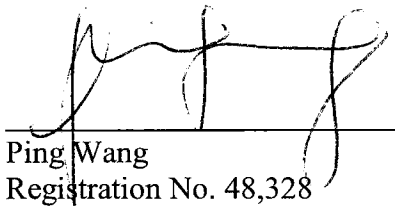
CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to contact Ping Wang (Reg. No. 48,328) at 202.842.0217.

Respectfully submitted,

MORRIS, MANNING & MARTIN, LLP



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